

1642

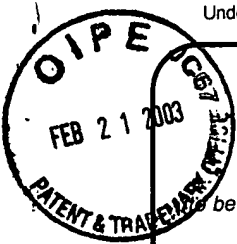
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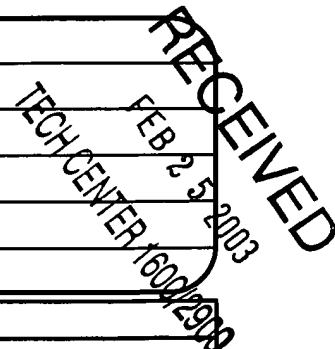


TRANSMITTAL FORM

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Application Number	09/847,046
Filing Date	April 30, 2001
First Named Inventor	Hevezi, et al.
Group Art Unit	1642
Examiner Name	Davis, Minh Tam
Attorney Docket Number	018501-008210US

Total Number of Pages in This Submission 6



ENCLOSURES (check all that apply)

- | | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form
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<input type="checkbox"/> Affidavits/declaration(s)

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<input type="checkbox"/> Express Abandonment Request

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<input type="checkbox"/> Response to Missing Parts/ Incomplete Application
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<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
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<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information

<input type="checkbox"/> Status Letter

<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Response to Restriction (2pp); Return Postcard |
|---|---|---|

Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm and Individual name	Townsend and Townsend and Crew LLP Kevin Bastian	Reg. No. 34,774
Signature		
Date	February 14, 2003	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box Amendment, Commissioner for Patents, Washington, D.C. 20231 on this date: February 14, 2003

Typed or printed name	Stephanie J. Whitehurst		
Signature		Date	February 14, 2003

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SF 1433011 v1



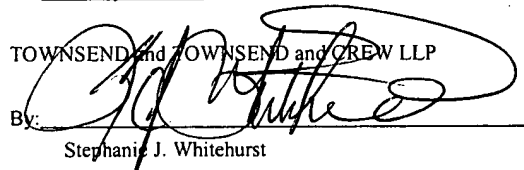
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PATENT
Attorney Docket No.: 018501-008210US
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On February 14, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: 
Stephanie J. Whitehurst

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 25 2003
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In re application of:

Hevezi, et al.

Application No.: 09/847,046

Filed: April 30, 2001

For: NOVEL METHODS OF
DIAGNOSIS OF PROSTATE CANCER
AND/OR BREAST CANCER,
COMPOSITIONS, AND METHODS OF
SCREENING FOR PROSTATE
CANCER AND/OR BREAST CANCER
MODULATORS

Examiner: Davis, Minh Tam

Art Unit: 1642

RESPONSE TO RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed January 14, 2003, Applicants elect with traverse to prosecute the claims of Group II directed to methods of diagnosing prostate cancer by determining the mRNA expression of a gene encoding PAA3. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching


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difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02). Applicants respectfully submit that both inventions in the present application can readily be searched without undue burden.

In light of the above, Applicants respectfully request that the restriction be withdrawn. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 576-0200.

Respectfully submitted,



Kevin Bastian
Reg. No. 34,774

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